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a susceptible host in an amount effective to elicit such response.

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~~15~~. A method for protecting a susceptible cat against feline immunodeficiency virus infection, said method comprising administering to said cat a vaccine comprising an immunogen selected from the group consisting of inactivated whole FIV and an inactivated FIV-expressing cell line, in an amount effective to elicit an immune response protective against infection by FIV.

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REMARKS

N D N K

Claims 1, 2, 4-8, and 10 were examined and rejected. Claims 1 and 6 have been amended. Claim 7 has been cancelled. New claims 14 and 15 have been added. Reexamination and reconsideration of the claims, as amended, are respectfully requested.

The provisional rejection of all claims for obviousness-double patenting is again acknowledged. Copending application serial number 07/995,304, remains pending. Assignee of the commonly owned applications will submit an appropriate Terminal Disclaimer on the latter-issued of the two cases.

The only other remaining rejection is stated under 35 U.S.C. § 112, first paragraph, and is based on lack of enablement for the "entire scope of the claims as written." Such rejection is traversed in part and overcome in part.

The Examiner argues that the disclosure enables claims only for vaccines "protective against FIV, where the immunogen is inactivated whole FIV or an inactivated cell line which expresses FIV antigens. The disclosure is not enabling for vaccines protected against viruses other than FIV, or for vaccines comprising FIV immunogens other than inactivated FIV-infected cell lines or inactivated, whole FIV (i.e., a vaccine comprising attenuated FIV, vaccines comprising individual FIV proteins or peptides)."

In an effort to place the application in better condition for allowance, Applicants have amended independent composition claim 1 to recite that the vaccine is "against feline immunodeficiency virus infection." Similarly, method claim 6 has been placed in independent form and recites that the method is intended for protecting a "cat against feline immunodeficiency virus (FIV) infection." Thus, it is believed that these independent claims clearly meet the first of the Examiner's requirements, i.e., they are specifically directed at vaccines and methods for vaccination against FIV.

Applicants have further added new independent claims 14 and 15 which are directed at vaccines and methods for vaccination, respectively. Vaccine claim 14 is similar to claim 1, but further recites that the immunogen is "selected from the group consisting of inactivated whole FIV and an inactivated FIV-expressing cell line." Independent vaccination method claim 15 is similar to claim 6, except that it further recites that the administered vaccine comprises "an immunogen selected from the group consisting of inactivated whole FIV and an inactivated FIV-expressing cell line." It is thus believed that both of these independent claims are allowable under the criteria defined by the Examiner in the Office Action.

Applicants continue to believe, however, that they are entitled to broader protection based on the enablement provided in their application as filed. While the Examiner is certainly correct that the application does not include working examples of an attenuated FIV vaccine or sub-unit vaccines comprising either peptides or proteins, Applicants believe that more credence should be given to the fact that their disclosure did provide evidence of successful vaccination using <u>both inactivated cell line vaccines and inactivated whole viral vaccines</u>.

As is well known to the Examiner, enablement of scope does not require that each and every species within a generic claim be described in the specification. See, e.g., *In re Sus*

and Schaefer, 134 USPQ 301 (CCPA 1962), where it is stated that "the public purpose on which the patent law rests requires the granting of claims commensurate in scope with the invention disclosed. This requires as much the granting of broad claims on broad inventions as it does the granting of more specific claims on more specific inventions." In the present case, it is believed that Applicants are the first to have conceived of, prepared, and successfully demonstrated the use of <u>any type of FIV vaccine</u>. Not only did they demonstrate a single type of FIV vaccine, they demonstrated the effectiveness of two distinct vaccine types, i.e., a whole virus vaccine and a viral-infected cell line vaccine. Based on such a disclosure, they are clearly entitled to claims of the broadest scope.

Applicants further believe that they should be entitled to claims having a broad scope based on the "pioneering nature" of their invention. It has been recognized that inventions of a pioneering nature are entitled to a broader scope of protection than inventions of a non-pioneering nature. See, e.g., *In re Hogan and Banks* 194 USPQ 527 (CCPA 1977), where it is stated that "as pioneers, ... [inventors] would deserve broad claims to the broad concept. What were once referred to as 'basic inventions' have led to 'basic patents' ...."

In the present case, the inventors were the discoverers of FIV, as reported in Pedersen et al. (1987) Science 235:790-793. Without this discovery, no one would have been able to prepare the claimed FIV vaccines. The inventors work, however, was not limited to discovery of the virus. Based on the discovery, the inventors were able to further develop vaccines as reported in their seminal publication, as well as in the present application.

For all of these reasons, Applicants respectfully submit that claims of a broad scope are entirely commensurate with the scope of their discovery and request that all remaining rejections be withdrawn and that all remaining claims be allowed and the application be passed to issue at an early date.

If for any reason the Examiner believes that a telephone conference would in any way expedite prosecution of the subject application, the Examiner is invited to telephone the undersigned at (415) 326-2400.

Respectfully submitted,

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